

## REMARKS

Claims 1-8 were pending prior to this amendment. Claims 1-8 stand rejected. Claims 14-17 have been added. At least in light of the above amendments and the foregoing remarks, issuance of the allowed claims is respectfully requested.

### *Claim Rejections – 35 U.S.C. § 103*

Claim 1 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,735,691 (Capps, et al.) and U.S. Patent No. 6,330,566 (Durham).

Capps is directed to a configuration manager that allows one to migrate a user's configuration settings from a first computer to a second computer. Stated examples of configuration settings are as follows:

- System settings
- Passwords
- Application configurations
- Account information
- Wallpaper
- Custom screen saver

The purpose of the Capps invention is to allow a user to transfer the exact settings from one computer to another so that the user has the same settings and other features on the second (e.g. newer) computer as on the first (e.g. older) computer. This contrasts with the purpose of the inventive method which is adapted to store new cookie values on the same computer which reflect updated web site visit/browsing information.

The Capps reference is cited by the Examiner as teaching three elements of claim 1, including the steps of storing a web page on a first server, uploading the web page to a visitor computer, and operating the data mining code from the web page on the visitor computer to obtain web browsing data. Applicants traverse on the following grounds:

#### A. *Capps Does Not Teach A Web Page Having Cookie Processing Script*

The Capps reference teaches the use of a migration manager 116 to collect configuration information from a source computer and automatically configure a destination computer with this information. Capps only uses the term “web page” once in the entire patent disclosure and then only to refer to an example of a user interface associated with an online service (Col. 10, line 20). There is no suggestion within Capps that the web page includes data mining code and cookie processing script as called for in pending claim 1.

Capps makes clear, in fact, that the data mining agent 304 which actually collects the configuration information is downloaded and invoked only after (Col. 10, lines 35-38) the user finishes selecting general configuration parameters by checking boxes on the presented

user interface. As the data mining agent is downloaded to the source computer only after the web page/graphic user interface, it can be clearly inferred that the web page itself (e.g. the graphic user interface presentation) would not include data mining code and cookie processing script.

*B. Capps Does Not Teach A Cookie Processing Script*

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The term “cookie” appears only once in the Capps patent (Col. 7, line 64) and only then in reference to the type of files that the data mining agent “opens” and “copies” as part of the configuration parameters. No processing of the cookie takes place in the Capps system since the only purpose of Capps is to copy certain files from one location to another.

It appears from the quote above that the Examiner has made the “data mining agent (304)” of Capps an equivalent to the “cookie processing script” in the present invention. Case law is fairly specific on how claim language is to be interpreted during prosecution. “Words in a claim are generally given their ordinary and accustomed meaning unless the inventor chooses to be his own lexicographer in the specification.” *Lantech, Inc. v. Keip Mach. Co.*, 32 F.3d 542, 547, 31 USPQ2d 1666, 1670 (Fed. Cir. 1994). “In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification.” *In re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). The Federal Circuit cautions, however, that the PTO is not to erroneously construe the claims (as was the case in *Baker Hughes*) where such construction was “beyond that which was reasonable in light of the totality of the written description.” *In re Baker Hughes, Inc.*, 215 F.3d 1297, 55 USPQ2d 1149 (Fed. Cir. 2000).

The fact that the data mining agent opens and copies data files such as cookies does not make the data mining agent a cookie processing script. No processing, as understood within the computer engineering arts, takes place. If the Examiner’s broad definition were to be accepted, then any program that is capable of copying cookies would be considered “cookie processing script”—surely such a broad reading is not intended.

Additionally, and more importantly, the Capps data mining agent does not perform critical functions that characterize the very definition of the cookie processing script: a cookie processing function that results in a modified cookie being stored. Applicants suggest, therefore, that the Examiner is associating an unreasonably broad meaning to the “cookie processing script” limitation in the pending claims in violation of case law under *Baker*

*Hughes* and related cases. Appellants thus respectfully submit that the claims as written are allowable over the Capps reference and combinations therewith.

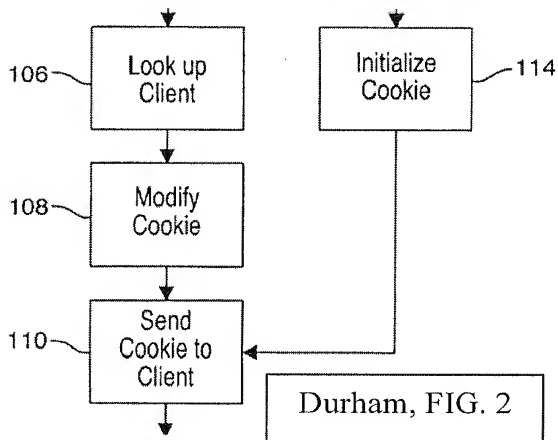
C. Capps Does Not Operate Data Mining Code On The Visitor Computer To Obtain Web Browsing Data

The present invention is directed to a method for tracking and reporting traffic activity on a web site. In the Capps reference, the terms “web site”, “traffic”, and “browsing data” do not appear. The purpose of Capps is not to track web traffic information. Instead, Capps is used to simply migrate configuration information from one computer to another. The values of the information copied is of no consequence to the Capps method—only that such values are exactly duplicated in the destination system.

While true that Capps does (but only a single time) that a copying operation involves cookie files, such an operation would not be interpreted in the art as obtaining web browsing data. Such a broad definition would run counter to the law as expressed in *Baker Hughes* and the related cases cited in the section above.

D. The Durham Patent Does Not Teach Operating Cookie Processing Script At The Visitor Computer To Obtain New Cookie Values

The Examiner has interpreted the newly cited Durham patent as teaching the steps of embedding cookie processing script within the web page, operating the script on the visitor computer to obtain new cookie values, and storing the new cookie values on the visitor computer. Applicants traverse on the grounds that Durham instead teaches changing the cookie outside of the visitor computer.



A portion of FIG. 2 of the Durham reference is shown to the left. According to Applicants’ reading of FIG. 2 and accompanying text at Col. 8, line 5 to Col. 9, line 52, Durham operates to generate cookie values in a remote server and only afterward transmits the cookie to the visitor computer. This process is clearly shown in Durham FIG. 2 where the step “send cookie to client” occurs after either “modify cookie” or “initialize cookie.”

Column 8 and 9 of the Durham patent discuss operation of various software subroutines operable on the server to process the cookie. Relevant sections explaining that the cookie is processed outside of the client computer include the following:

- “The server can also modify 106 the client’s cookie before sending 110 it back to the client in an HTTP response from the server.” (Col. 8, lines 2-4)
- “[A] new cookie [is] initialized (generated) 144. This cookie is then sent 110 to the client so that a personalized page can be generated 116 for the client.” (Col. 8, lines 10-12)
- “[T]he client elects particular preferences which are then forwarded to the server. These preferences are stored in a database, as well as encoded into a cookie.” (Col. 9, lines 39-40)

The Examiner cites to a portion within the Summary of Invention section of Durham as teaching operation of the cookie processing script at the visitor computer. (Col. 3, lines 22-41) This interpretation is incorrect. Instead, the text clearly states (and is confirmed by FIG. 2) that a compressed cookie is built at the server and passed to the user’s browser in an HTTP response to the original client contact (see, e.g. Col. 3, lines 37-38 and Col. 10, lines 4-8).

As the cookie is set and further processed outside of the client, there would be no need to embed cookie processing script within the web page under the Durham regime. The cookie is simply received at the client computer and stored as received. As Durham does not teach or suggest the step of operating the cookie processing script at the visitor computer, rejection of the claims under 35 U.S.C. §103(a) is insufficient as a matter of law.

*E. It Would Not Be Obvious To Implement The Features Of Pogue Within Capps And Durham*

All pending claims have been rejected under §103(a) as being an obvious combination of several references (Capps, Durham, Pogue, and Shrader). These references teach very different aspects of computer usage, including:

CAPPS – computer setting migration manager (does not involve traffic analysis)

DURHAM – method for storing compressed cookies (does not involve traffic analysis)

POGUE – visitor tracking programs for traffic analysis

SHRADER – cookie construction and validation method for client authentication.

The attempted combination of all of these disparate references to teach elements of a single claim rises to the level of hindsight analysis that runs counter to obviousness analysis as articulated by the law and interpreted by the courts.

The Federal Circuit has been consistent in reversing the PTO when a rejection is made on the basis of hindsight, that is when an Examiner rejects the application under 35 U.S.C. §103(a) grounds as obvious under a combination of two or more patents without any specific

suggestion within the patents to combine the features. In re Rouffett, 47 USPQ2d 1453 (Fed. Cir. 1998), the Federal Circuit refused to uphold an obviousness rejection, even where skill in the art is high, absent the specific identification of principal, known to one of ordinary skill in the art that suggests the claimed combination.

The Federal Circuit reemphasized the care to be taken when combining prior art references in obviousness findings in Ecolochem v. Southern Cal. Edison, 56 USPQ2d 1065 (Fed. Cir. 2000), stating that such absence of evidence to combine prior art references “is defective as hindsight analysis.” The Federal Circuit held similarly in In re Kotzab, 55 USPQ2d 1313 (Fed. Cir. 2000), reversing the PTO and stating that, “[i]dentification of prior art statements that, in abstract, appear to suggest claimed limitation does not establish prima facie case of obviousness without finding as to specific understanding or principal within knowledge of skilled artisan that would have motivated one with no knowledge of the invention to make the combination in the manner claimed.”

Finally, the Federal Circuit has reaffirmed their view that the PTO used improper hindsight analysis to reject patent claims under §103(a) in the recent case of In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), stating that a specific suggestion in the prior art cited is required and not a simple citation to “common knowledge and common sense.” Lee includes a tour-de-force of case law directed to the issue of combining references including those as follows:

- “The factual inquiry whether to combine references must be thorough and searching. . . . It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.” (Lee, 277 F.3d at 1343)
- “A showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding.” (*quoting* Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000)
- “Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” (*quoting* C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)

- “There must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant.” (*quoting In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998).
- “Teachings of references can be combined *only* if there is some suggestion or incentive to do so.” (*quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (emphasis in original)

The Patent Office has failed to display the rigor required by the Federal Circuit holdings in demonstrating a suggestion within the art that the cited prior art references should be combined. For instance, the primary reference Capps concerns itself solely with a method for migrating user settings from a source computer to a destination computer. Capps does not address web site browsing, does not implicate web traffic tracking, and does not teach cookie manipulation. Whereas the present invention is directed to the client-side processing of a cookie to overcome security features against third-party cookies, Capps is not even in the same field of study.

It would seem, in fact, that Capps teaches away from the present invention. The present invention results in new (e.g. most likely different) cookie values. In contrast, the whole purpose of Capps is to transfer the same configuration information. Transferring different configuration information would defeat the whole purpose of Capps. Furthermore, Capps confines itself to the transfer of settings from one client computer to another. In contrast, the present invention stores new cookie values on the same computer.

Finally, none of the references teach the core concept of client-side cookie processing as the cited art of record only teaches that such duties are handled by external servers. No motivation has been presented for picking and choosing elements from various independent embodiments across multiple patents without the inference of hindsight. Accordingly, the four references fail as a matter of law to (1) teach all elements of the claims, and (2) suggest that combination would be possible given the desperate fields of endeavor and goals of the various references cited. Reconsideration and allowance of all claims is thus respectfully requested.

*F. Pogue Does Not Attach The New Cookie Values To An Image Request Associate With A Designated URL Source (Claim 3)*

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Claims 2, 3 and 5-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Capps, et al. and Durham as applied to Claim 1, and further in view of U.S. Patent No. 6,112,240 (Pogue, et al.)

Claim 3 includes the steps of “attaching the new cookie values to an image request” associated with a designated URL source, and “sending the image request to the URL source.” An example of this action would be to send the newly provided cookie values from the visitor computer to a tracking computer.

Pogue does not describe this feature. Citing to the portion identified by the Examiner (Pogue, Col. 7, lines 11-22), Pogue instead only transmits a new cookie from the tracker 310 to the browser 302 thereby replacing the cookie on the visitor computer. Pogue does not teach that the cookie is then attached to an image request associated with a designated source. Reconsideration and allowance of the claims is thus respectfully requested.

Claim 4 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Capps, et al. and Durham as applied to claims 1-3, and further in view of U.S. Patent No. 6,374,359 (Shrader, et al.). Because the combination fails to teach each and every element claimed as described in the sections above, claim 4 should be in condition for allowance and reconsideration is solicited.

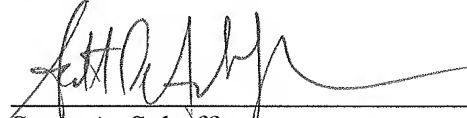
#### CONCLUSION

The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

**Customer No. 20575**

Respectfully submitted,

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